UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,384	11/08/2000	James R. Hansen	11333-014001	2155

26161   7590   11/08/2005

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EXAMINER
VU, THONG H

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/708,384	HANSEN, JAMES R.
	Examiner	Art Unit	
	Thong H. Vu	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>04 August 2005</u>.
2a) ☐ This action is **FINAL**.　　2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>See Continuation Sheet</u> is/are pending in the application.
　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1,6-10,12,15,21-22,27-31,33,36,42,43,48-52,54,57-59,65-68,71-84 and 89-114* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
　　a)☐ All　b)☐ Some * c)☐ None of:
　　　1.☐ Certified copies of the priority documents have been received.
　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.
　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date *9/05*
4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

Continuation of Disposition of Claims: Claims pending in the application are 1,6-10,12,15,21,22,27-31,33,36,42,43,48-52,54,57-59,65-68,71-84 and 89-114.

1.   Claims 1,6-10,12,15,21-22,27-31,33,36,42,43,48-52,54,57-59,65-68,71-84 and

new claims 89-114 are pending. Claims 2-5,11,13,14,16-20,23-26,32,34-35,37-41,44-

47,53,55-56,60-64,69-70,85-88 are cancelled.

Claim Rejections - 35 USC § 112

2.   Claims 1,15,22,36,43,59,68,89,97,105,114 are rejected under 35 U.S.C. 112,

second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. It was unclear the

device or the remote computer or the apparatus lacking of a public network address and

which ones connect to the public network hand how they connected to each others.

Claim Rejections - 35 USC § 101

3.   The disclosed invention is inoperative and therefore lacks utility. (i.e. : lacking a

public network is not in specification).

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created
doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
unjustified or improper timewise extension of the "right to exclude" granted by a patent
and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,
418 F.2d 528, 163 USPQ 644 (CCPA 1969).
       A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
       Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

('714) 1. A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer that cannot directly address the device, the method comprising:

detecting the state of the apparatus, wherein detecting is performed by monitoring variables associated with the apparatus, the monitoring occurring independently of communications from the remote computer;

generating a message that reports the state of the apparatus using a self-describing computer language, wherein generating is performed periodically or in response to a deviation in the state;

sending the message to the remote computer; wherein the deviation is indicative of an error condition in the apparatus, and wherein the error condition comprises one or more variables that deviate from an acceptable value or a predetermined range of acceptable values.

5.   (Application) 1. A method performed by a device associated with an apparatus to report a state of the apparatus to a remote computer lacking a public network address that can be used by the remote computer to initiate communication with the device, the method comprising:

detecting the state of the apparatus wherein detecting is performed by monitoring variables associated with the apparatus;

generating a message that reports the state of the apparatus, the message comprising a Hyper-text Transfer Protocol (HTTP) command, the message using extensible Markup Language (XML) to report the state, and the message containing an identifier that is unique to the apparatus, wherein generating is performed periodically or in response to a deviation in the state; and sending the message to the remote computer.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1,6-10,12,15,21-22,27-31,33,36,42,43,48-52,54,57-59,65-68,71-84 and

89-114 are rejected under 35 U.S.C. § 103 as being unpatentable over Smith et al

[Smith 6,785,015 B1].

7.   As per claims 1, 89 and 114, Smith discloses A method performed by a device

associated with an apparatus to report a state of the apparatus to a remote computer

lacking a public network address that can be used by the remote computer to initiate

communication with the device, the method comprising:

        detecting the state of the apparatus wherein detecting is performed by monitoring

variables associated with the apparatus [Smith, process monitor, col 10 line 42 et seq];

        generating a message that reports the state of the apparatus [Smith, reporting a

new state variable, col 14 lines 10-25], the message comprising a Hyper-text Transfer

Protocol (HTTP) command, the message using extensible Markup Language (XML) to

report the state [HTML, XML col 4 lines 37-65], and the message containing an identifier

that is unique to the apparatus [Smith, identifier of a host computer, col 5 lines 17-39],

wherein generating is performed periodically or in response to a deviation in the state

[Smith, period of time, col 6 lines 1-33; error status, col 11 lines 1-6]; and

        sending the message to the remote computer [Smith, send message via Internet,

col 4 lines 20-65] .

8.   As per claim 6, Smith discloses detecting the state comprises receiving the state

variables from the apparatus [Smith, col 10 lines 42 et seq.].

9.   As per claim 7, Smith discloses detecting the state comprises detecting the

variables periodically from the apparatus [Smith, col 12 lines 8-32].

10.   As per claim 8, Smith discloses obtaining an identifier for the apparatus, and

reading the variables state from the apparatus using the identifier [Smith, col 8 line 50-

col 9 line 30].

11.   As per claim 9, Smith discloses determining the deviation (i.e.: error condition)

[Smith, error descriptions, collection status and changes configuration by monitor

process, col 11 lines 1-21]

12.   As per claim 10, Smith discloses comparing the state to a previous state of the

apparatus [Smith, comparing portions of the message, col 13 lines 40-57].

13.   As per claim 12, Smith discloses the message is generated using a predefined

template, the message being generated by obtaining one or more variables relating to

the; and inserting the one or more variables into the template [Smith, conventional file

format, col 5 lines 17-37].

14.   As per claim 13, Smith discloses the state of the apparatus is included as part of

a body of the message [Smith, the body of the email, col 5 lines 17-37].

15.   As per claim 14, Smith discloses the state of the apparatus is included as part of

an attachment to the message [Smith, email attachment, col 5 lines 17-37].

16.   As per claim 77, Smith discloses the device is embedded in the apparatus

[Smith, network controller 614, Fig 6].

17.   As per claim 83, Smith discloses the message includes past states of the

apparatus [Smith, prior messages, col 12 lines 65].

18.   Claims (15,21,78,84);(22,27-31,74,79);(36,42,80);(43,48-52,54,57,58,75, 81);

(59,65-67,82);(68,71,72,76);(84,90-96) and 97 contain the similar limitations set forth

claims 1,6-10,12,73,77,83. Therefore claims (15,21,78,84);(22,27-31,74,79);(36,42,80);

(43,48-52,54,57,58,75,81);(59,65-67,82);(68,71,72,76);(84,90-96) and 97 are rejected

for the same rationale set forth in claims (1,6-10,12,73,77,83).

19.   As per claim 90 Smith discloses monitoring comprises (a) obtaining identifiers for

variables associated with the apparatus, the identifiers corresponding to storage

locations for the apparatus, and (b) reading the variables from the storage locations

[Smith, col 10 line 42-col 11 line 21].

20.   As per claim 91 Smith-Biffar disclose obtaining the XML tags using the identifiers, the XML tags being stored in a database in association with the identifiers [Smith, database, col 9 lines 57-65].

21.   As per claim 92 Smith discloses the HTTP command comprises a POST command as inherent feature of HMTL application.

22.   As per claim 93 Smith discloses the message comprises one or more of the following: data identifying a type of the device, a common name for the device, a manufacturer of the device, a model name of the device, a model number of the device, a serial number of the device, and a universal unique identifier for the device [Smith, any suitable variation in the type and number of workstation, col 3 lines 57-67].

23.   As per claim 94 Smith discloses the state comprises both an error condition and a measurement associated with the apparatus that is not an error condition [Smith, monitor process, col 10 line 42 et seq].

24.   As per claim 95 Smith discloses the storage locations comprise register locations corresponding to hardware associated with the apparatus [Smith, register, col 10 lines 32-42].

25.   As per claim 96 Smith discloses the message includes a history log providing

past states of the apparatus [Smith, database, col 9 lines 57-65].

26.   Claims 97-104; 105-113 contain the similar limitations set forth claims 89-96.

Therefore claims 97-104; 105-113 are rejected for the same rationale set forth in claims

89-96.

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-
272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM-
3:30PM.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the
organization where this application or proceeding is assigned is 571-273-8300
        Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval IPAIRI system. Status information for published
applications may be obtained from either Private PMR or Public PMR. Status
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have questions on access to the Private PAIR system, contact the Electronic Business
Center (EBC) at 866-217-9197 (toll-free).

Thong Vu
Primary Examiner
Art Unit 2142